UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,599	04/25/2001	Bao Tran	AFL-012	9367

31688 7590 06/13/2008

TRAN & ASSOCIATES
6768 MEADOW VISTA CT.
SAN JOSE, CA 95135

EXAMINER	
WEISBERGER, RICHARD C	
ART UNIT	PAPER NUMBER
3693	

MAIL DATE	DELIVERY MODE
06/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/842,599
Filing Date: April 25, 2001
Appellant(s): TRAN, BAO

Tran
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/12/2008 appealing from the Office action mailed 10/05/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Riordan, "Long Before That Mouse Trap is Officially Certified, You Can Market It On The Web, New York Times, March 2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 16-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In response to the Non-Final Office Action, the applicant amended independent claim 1 to include "a user interface displayed by the processor to store information on the IP asset including rating information". The applicant points to pages 7-8 for support. No support exists for "ratings information".

Examples of industry accepted meanings of a ratings elements include the following (having in a alphabetical or numeric representation of source data):

- Designations giving relative indications of a company's or governmental agency's credit history. www.ent.com/investing/glossary.asp
- Various alphabetical and numerical designations used by institutional investors, Wall Street underwriters, and commercial rating companies to give relative indications of bond and note creditworthiness. Standard & Poor's and Fitch Investors Service Inc. ... www.mello-roos.com/glossary.htm
- Radio, cable and broadcast television programming measure their performance via ratings. en.wikipedia.org/wiki/Ratings (broadcast)

The applicant's appeal brief references the specification in response to the new matter rejection. These section fail to support the ***system claim components*** claimed.

As to claim 21, page 3, lines 25-30 and page 9, lines 21-24 fail to teach that the PIM permits sellers to list assets for sale, buyers to bid on assets of interest and users to browse through listed items in a fully-automated, topically-arranged, intuitive and easy- to-use online service.

As to claim 22, page 3 lines 26-28 fail to teach that the PIM provides real time and interactive auctions that allows bidders place bids in real time and compete with other bidders using the Internet.

As to claim 23, page 3, lines 28-30 fail to teach that the PIM allows customer bids to be automatically increased up to a maximum amount so bids can be raised and auctions won even when bidders are away from their computers.

As to claim 24, page 4, lines 3-9 fail to teach that the PIM provides the user with access to a social network.

As to claim 25, page 4, lines 3-9 fail to teach that the PIM provides the user with access to a network of IP lawyers for assistance in finalizing the applications, specialists for trading IP, venture capitalists and financiers.

As to claim 26, page 4 lines 14-15 fail to tech that the PIM displays advertisements for a predetermined period of time.

As to claim 27, page 17, line 10 and page 1 line 23 fail to teach that the PIM allows an inventor to file a patent application with a patent office.

As to claim 28, page 17 line 10 fail to teach that the PIM allows an inventor to file a patent application.

As to claim 29 page 3 line 19 and page 4 lines 7-10 fails to tech that the PIM automatically updates the user on any new IP in the user's areas of interest.

As to claim 30 page 6 line 27 and page 7 lines 22-31 fails to teach that the PIM provides an appraisal of the IP.

As to claim 31 page 8 lines 15-28 fail to teach that the PIM provides escrow to facilitate an IP transaction.

As to claim 32, page 12 lines 26-31 fail to teach that the PIM provides a virtual showroom which displays the IPs offered for sale and enables a potential purchaser or customer to view the IP asset, view rating information regarding the IP asset or place a bid to purchase the IP asset.

As to claim 33, page 13 lines 1-6 fail to teach that the PIM accesses one or more search engines that continuously search the web and identify information that is of interest to the user.

Claims 1 and 16-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation “rating information" is indefinite in scope as it is not clear aspect of the patent is being rated not is it clear what algorithm converts the raw data to a ratings system.

The limitation "predetermined time" is a measurable unit that is indefinite in scope as to how it is predetermined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 16-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Riodan.

The prior art teaches a system to support trading of intellectual property (IP), comprising:
a processor; a user interface displayed by the processor to accept a request to trade an IP asset; a database coupled to the user interface and to the processor to store data. associated with one or more IP assets, the database supporting the trading of the IP asset (page 2, 4th full paragraph).

The examiner took official notice that the ratings modules are well known in the art of electronic assets markets. Ratings modules reduce the time it takes to make a decision to buy an asset. This official notice has not been seasonably challenged. It would have been obvious for one skilled in the art at the time to have rated the IP assets as motivated by the need to increase the time to sell and the due diligence expense related to the buying of the asset.

As for claim 16, the system of claim 1, further comprising an online platform for selling and buying patentable ideas or pending patent applications, see page 2, 4th full paragraph.

As for claim 17, the system of claim 16, wherein parties can list and search for applications that are within a predetermined period from abandonment, see "patent pending" at page 2, 4th full paragraph.

As for claim 18, the system of claim 1, wherein the network is the Internet and wherein clients access the system using a browser, see page 2, 4th full paragraph.

As for claim 19, the system of claim 18, further comprising a patent information management (PIM) system to display information for a user to manage the user's IP and to communicate with other users relating to the IP(page 2, 4th full paragraph). .

As for claim 20, the system of claim 19, wherein the PIM provides information on pending activities relating to an IP asset see page 2, 4th full paragraph and wherein the user drills down to get additional information on the IP asset (the limitation directed to the user has been given no patentable weigh).

As for the modules of clams 22-34, the examiner took official notice that each of these software constructs are well known in the field of electronic auction markets. This statement has not been challenged. Collectively the software modules of claims 21-26 are either related to the graphical user interface, the auction functionality, or linking to an external web site or database. It would have been obvious for one skilled in the art to implement each of these modules in the system of the prior art as motivated by each of their recognized benefits. As for claims 28-34, these are all modules that are directed to methods inherent in the patent prosecution/patent sale or licensing practice. It would have been obvious for one skilled in the art at the time to have added these well known modules as motives to add services up and down the value chain of the yet2.com business described in the prior art.

(10) Response to Argument

The applicant argues that Under *Vaeck,* absent any evidence of a cited suggestion or reasonable motivation for modifying Riodan to arrive at claims 1 and those dependent therefrom renders the *prima facie* obviousness rejection improper.

This argument is inconsistent with the court opinion in *KSR Int'l. Co., v. Teleflex Inc. et al,* wherein the Supreme Court unanimously rejected the Federal Circuit's rigid use of its "teaching, suggestion, or motivation" (TSM) test in determining obviousness. In rejecting the Federal Circuit's application of the TSM test, the Court noted its concern of confining the obviousness analysis to a "formalistic conception of the words teaching, suggestion and motivation" and overemphasizing "the importance of published articles and the explicit content of issued patents". The Court further reiterated that a patent claim can be found obvious by a showing that a combination of elements is obvious to implement. Morever, as the applicant has not challenged the official notice, the prima facie case is proper under this same courts holding in se (*Sakraida* 1976), where the court held that a combination which only unites old elements with no change in their respective functions is precluded from patentability under 103(a).

Here, the record shows that there is no novelty in any component of the claimed "system". Rather, the applicant has merely taken the core/critical elements of his system and added borrowed modules that either exist in other electronic market auction systems or are well known methods found up and down the value chain of electronic IP auction environments like Yet.com (discussed in the primary reference). These modular extensions of a system to include elements well known in the art or to include methods steps well known in the value chain are the types of limitations that fail to render an otherwise unpatentable invention patentable. The court's

holdings clearly recognize how hazardous to the patent system this type of claim to patentability is and how it muddies the water of true innovation.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Richard C Weisberger/
Primary Examiner, Art Unit 3693

Conferees:
/J.A.K./
James A. Kramer
Supervisory Patent Examiner, Art Unit 3693

Vincent Millin /VM/
Appeal Specialist, TC 3600